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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,333	02/11/2005	John Philip Griffiths	GRIJ0101 PUSA	6942

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EXAMINER

JIANG, YONG HANG

ART UNIT	PAPER NUMBER
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2609

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/30/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/524,333	Applicant(s) GRIFFITS ET AL.	
	Examiner Yong Hang Jiang	Art Unit 2609	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/11/2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 2/11/2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>1/17/2006</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-9, and 17-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1, and 3-5 the word "means" is preceded by the word(s) "electronic" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

Regarding claim 17, the word "means" is preceded by the word(s) "electronic" or the word(s) "second" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

Claims 2, 6-9, and 18-20 depend on claims 1 or 17; therefore they have the same deficiency.

4. Claims 10-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Regarding claim 10, the term “and/or” renders the claim indefinite as it is not clear whether the indicator is electronically operable and addressable, operable only, or addressable only.

Claims 11-15 depend on claim 10; therefore they have the same deficiency.

Regarding claim 15, the phrase “manufactured as an integral part of one at least keys” renders the claim indefinite as the claim of which claim 15 depends on explicitly states that the indicator is not manufactured as an integral part of a key but rather coupled to a key.

Claim 16 depends on claim 15; therefore it has the same deficiency.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-20 are rejected under 35 U.S.C. 101 because the claims are directed to neither a “process” nor “machine”, but rather overlaps two different statutory classes of invention set forth in 35 U.S.C. 101.

Regarding claim 1, the method of “physically coupling a device” falls under statutory class Process, while “a device that includes an electronic means to one at least keys” falls under statutory class Machine, therefore claim 1 is considered non-statutory as it overlaps two different statutory classes.

Claims 2-9, and 17-20 depend on claim 1; therefore they have the same deficiency.

Regarding claim 10 the method of “physically coupling a device” falls under statutory class Process, while “electronically operable and/or addressable indicator means to one at least keys” falls under statutory class Machine, therefore claim 10 is considered non-statutory as it overlaps two different statutory classes.

Claims 11-16 depend on claim 10; therefore they have the same deficiency.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-5, 7, 9-14, and 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Maloney (6,204,764).

Regarding claims 1-2, Maloney discloses a method of coupling an electronic device to a key via a key card (11) with a radio identification tag (19) and an attachment lug (24) to attach a key when the key is not attached to a key grouping means (col. 6, lines 11-32).

Regarding claim 3, Maloney discloses coupling a key after manufacturing of said key via an attachment lug (24) on key card (11) to attach said key (col. 6, lines 21-24).

Regarding claim 4, Maloney discloses means for addressing via a radio frequency identification (RFID) tag (19) containing identification code for detecting the presence of a key (col. 8, lines 1-20).

Regarding claim 5, Maloney discloses means for indication via RFID tag (19) to indicate the presence of a key (col. 8, lines 1-20).

Regarding claim 7, Maloney discloses means for an electronically readable ID via a stored identification code on RFID tag (19) to be decoded by RF decoder (66) (col.8 lines 11-20).

Regarding claim 9, Maloney discloses a method of selecting one key with means for identification to facilitate the selection of a key from other keys via the activation of RFID tag (52) upon selection by radio frequency sensors (col. 9, lines 48-62).

Regarding claim 10, Maloney discloses a method of coupling an electronically operable indicator via RFID tag (19) attached to key card (11) with a key attached (col. 6, lines 11-32).

Regarding claim 11, Maloney discloses a method of selecting one key with means for identification to facilitate the selection of a key from other keys via the activation of RFID tag (52) upon selection by radio frequency sensors (col. 9, lines 48-62).

Regarding claim 12, Maloney discloses means for indication to facilitate inputting of information via memory (74) on RFID tag (71) for inputting (storing) the unique code of the RFID tag pertaining to a key (col. 8, lines 35-39).

Regarding claim 13, Maloney discloses means for indication being a component part of Local Key means via RFID tag (19) as it is a component part of key card (11) (col. 6, lines 11-32).

Regarding claim 14, Maloney discloses retrofitted means for indication to a key via RFID tag (19) on key card (11) with an attachment lug (24) to retrofit a key.

Regarding claim 17, Maloney discloses operation of means for electronic devices via RFID tags (52) being facilitated by means for a secondary device via memory (74) inherently coupled by a conductor to the RFID tag (52) (col. 9, lines 48-62).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maloney as applied to claims 1 and 5 above, and further in view of Inoue (JP 2000207657).

Regarding claim 6, Maloney discloses all the structural elements of the claimed invention but fails to disclose means for illumination.

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Inoue teaches a light-emitting element (4) such as a LED (light emitting diode) attached to a tag (3) with ring (2) to a key (1) to track and identify a key when it is lost in the abstract of (JP 2000207657).

From the teachings of Inoue, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the key-card of Maloney to include the LED disclose by Inoue to make the key-card easily identifiable when the LED is emitting light, thereby making searching for it easy when the key-card is missing (abstract of JP 2000207657).

12. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maloney as applied to claims 1 and 7 above and Official Notice.

Regarding claim 8, Maloney discloses all the structural elements of the claimed invention but fails to disclose means for identification of a lock for a key to action. The examiner takes Official Notice that it is old and well known to store identification codes on a RFID for object identification. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to store the identification of a lock on the RFID tag (19) to easily identify a lock to be unlocked, RFID tags comprises memory storage for identification codes, thereby making selection of keys easier.

13. Claims 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maloney as applied to claim 10 above and further in view of Ostermann et al. (5,798,576).

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Regarding claims 15 and 16, Maloney describes all the structural elements of the claimed invention but fails to disclose manufacturing means for indication as an integral part of a key's handle.

Ostermann teaches an electronic key system with a portable electronic key (1) integrated with a mechanical key (1a). (See the Sole Drawing in the invention and column 4 lines 56-66).

From the teachings of Ostermann, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the key-card of Maloney to include manufacturing a mechanical key with the key-card and an indicator on the handle as an integral part, thus making the mechanical key easier to handle. (See the Sole Drawing in the invention and column 4 lines 56-66).

14. Claim 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maloney and Official Notice.

Regarding claim 18, the examiner takes Official Notice that electrical conductors are old and well known as they are used extensively on electrical circuits as a cheap and easy to find conductor for circuit connections, therefore, it would have been obvious for one of ordinary skill in the art at the time the invention to use electrical conductors.

Regarding claim 19, Maloney discloses means for a secondary device including means for grouping keys via container (41) bearing an RFID tag.

Regarding claim 20, Maloney discloses means for a secondary device including a key control means via memory (74) for storing the identification code of a RFID tag.

Conclusion

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15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Hang Jiang whose telephone number is 571-270-3024. The examiner can normally be reached on M-F 7:30 am to 5:30 pm alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynda Jasmin can be reached on 571-270-3033. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JYH



BENNY TIEU
PRIMARY EXAMINER